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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,452	06/25/2001	Prabhakar Gopalan	AUS920010328US1	8688

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IBM CORPORATION (RUS)
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2100 Ross Avenue
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EXAMINER

JUNG, DAVID YIUK

ART UNIT	PAPER NUMBER
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2134

MAIL DATE	DELIVERY MODE
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10/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 09/888,452	Applicant(s) GOPALAN, PRABHAKAR	
	Examiner David Y. Jung	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-13, 18 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-13, 18, 21-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2007</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

CLAIMS PRESENTED

Claims 1-13, 18, 21-26 are presented.

Response to Amendment

Applicant's arguments, with respect to the rejections of claims have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in view of the new art and new consideration.

CLAIM REJECTIONS

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Regarding claims 1-13, 18, 21-26, the claimed invention is directed to non-statutory subject matter. Claims recite only perfunctory recitation of functional material (database, programmable apparatus, etc.). Aside from this, the claims recite only nonfunctional descriptive material. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e.,

Art Unit: 2134

abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”). Such a result would exalt form over substance.

USPTO personnel should determine whether the claimed nonfunctional descriptive material be given patentable weight. USPTO personnel must consider all claim limitations when determining patentability of an invention over the prior art. In *re* *Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983). USPTO personnel may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384, 217 USPQ at 403; see also *Diehr*, 450 U.S. at 191, 209 USPQ at 10. However, USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004).

For further guidance on the term “nonfunctional”, please see MPEP 2106. As a reference, one may look to the amicus curiae brief from the USPTO in the US Supreme Court case of *Microsoft vs. ATT* (decided April 30, 2007, after Applicant’s filing of Appeal Brief).

Claim Rejections - 35 USC § 103

Art Unit: 2134

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Regarding the factual inquiries, the USPTO, in light of new court decisions, have noted that other appropriate consideration in addition to "TSM (teaching, suggestion, motivation)" may be considered. See the USPTO website and Official Gazette.

Claims 1-13, 18, 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Passport (Odds & Ends January 2000 • Vol.8 Issue 1, The Safety Net Of Passport Your Ticket For Electronically Transporting Your Wallet Online).

Regarding claim 1, Passport approximately teaches "A [] comprising: a centralized personal data base in a first computer, the centralized personal database being accessible by a consumer having a basic number (section "step 2", e.g., some information such as passwords are not given away) and a primary number and

Art Unit: 2134

accessible to a merchant having the primary number and a secondary number; a network; a second computer connected to the first computer by the network; wherein the consumer creates an account in the centralized personal data base (section "step 2", e-wallet has personal data base) using the basic number and the primary number; wherein the consumer uses the basic number and the primary number to access the account in the centralized personal data base and the consumer can modify an account data in account; wherein the consumer creates the secondary number and provides the primary number and the secondary number to the merchant wherein the merchant (section "step 4" merchant fulfills order) uses the primary number and the secondary number to access the account and the merchant is prohibited from modifying the account data in the account (section "step 4" merchant fulfills order, of course merchant cannot modify the personal information of the consumer)."

These passages of Passport do not use the "programmable apparatus" in the sense of the claim. Instead, Passport uses the entire Internet to actuate the transactions.

Nevertheless, it was well known in the art to use networked computing (such as the use of resources of the Internet) for the motivation of handling many users.

Hence, it would have been obvious to those of ordinary skill in the art at the time of the claimed invention to modify the teachings of Passport for the motivation noted in the previous paragraphs so as to teach the claimed invention.

Claims 4, 7, 10, 11, 13, 26: see section step 2, step 3, step 4 – the numbers of merchant and consumer are handled by Passport.

Art Unit: 2134

Claims 5-6, 8-9, 12, 24, 25: Passport does not directly teach such situation of notification between consumer and merchant. Nevertheless, it was well known in the art to use notifications between consumer and merchant. This must be considered the ordinary skill in the art because of the notification process was already a common occurrence between any parties to transaction. For example, note the need for data integrity during transaction, which would necessitate some notification process.

Claims 18, 21-23 are method analogs and computer readable memory analogs to claim 1. The scope of the claims is substantially similar to claim 1. See section step 2, step 3, step 4 – the numbers of merchant and consumer are handled by Passport.

Conclusion

The art made of record and not relied upon is considered pertinent to applicant's disclosure. The art disclosed general background.

Points of Contact

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Art Unit: 2134

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-3836 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Jung whose telephone number is (571) 272-3836 or Kambiz Zand whose telephone number is (272) 272-3811.

David Jung

Patent Examiner

10/16/07

A handwritten signature in black ink, appearing to be 'David Jung', written over a horizontal line.